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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,116	12/05/2000	Robert Manuel Carmichael	1064.8002	8544
44538 7590 08/13/2007 DANIEL S. POLLEY, P.A. 1215 EAST BROWARD BOULEVARD FORT LAUDERDALE, FL 33301			EXAMINER VASUDEVA, AJAY	
			ART UNIT 3617	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/730,116

Applicant(s)

CARMICHAEL, ROBERT MANUEL

Examiner

Ajay Vasudeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 is/are allowed.
- 6) ☒ Claim(s) 2-6, 12, 13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Rejection based on new grounds***

1. A rejection based on new grounds has been introduced in this Office Action, with the allowability of certain claims being withdrawn in view of Double Patenting issues.

Additionally, this Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

This Office Action is a non-final action. The examiner regrets the resulting inconvenience to the applicant and his counsel.

### ***Requirement for Information Under 37 CFR § 1.105***

2. 37 CFR 1.105. Requirements for information:

(a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(2) ...

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

3. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to treat a matter in this application, which pertains to the issue of a possible public use, sale activity, or an offer for sale in the United States more than 1 year prior to the effective filing date of the application.

4. This is a request that applicants provide certain information identified below. If applicants have this information, the applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.

5. Applicant is not required or being asked to conduct a search for information beyond applicants own immediate files. If applicant does not have immediate knowledge of the requested information, then a statement that the information sought is unknown or not readily available to the applicants will be accepted by the office as a complete reply.

6. **Why the Request for Information is Reasonably Necessary:**

Background:

- (i) The effective filing date of the instant application is held to be 12/05/2000.
- (ii) Applicant filed a declaration on 04/04/2005 -- based partially on a supporting affidavit by Mr. Joseph Stella (hereby Stella Affidavit) submitted earlier on 8/03/2004 -- to overcome 35 USC 102(e) and 102 (f) rejections based on US 6,527,480 B2 ('480).
- (iii) Mr. Stella represents the company that is the assignee of record in the '480 Patent identified above. It is noted that the Applicant did not originally supply Exhibit C identified in the Stella Affidavit at the time of the filing of the Affidavit on 8/03/2004. Exhibit C was made available only on 04/04/2005 after the Examiner made a request for the same (see Office action dated 12/01/2004).

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Reasons for requesting the information:

The information found within the supporting Stella affidavit leads examiner to many questions. Examiner would like to conclusively ascertain whether or not the instant invention was in public use, sale activity, or an offer for sale in the United States more than 1 year prior to the effective filing date of the application.

Indicators include:

1) On page 3, ¶8 of the Stella affidavit, the affiant noted:

"For example, SCUBAPRO receives Skin Diver Magazine. In the December 1999 issue of Skin Diver that I received, I saw an advertisement for the ACB System. A true and correct copy of that Skin Diver Magazine is attached hereto as Exhibit C". (emphasis added)

2) Further, in ¶9, the affiant stated:

"In addition, when I attended DEMA 2000, in January 2000, I saw the ACB System displayed at Halcyon's booth".

**7. Information Requested of Applicant:**

(a) Is the Active Control Ballast (ACB) System advertised in the December 1999 issue of the Skin Diver magazine (Exhibit C of the Stella Affidavit) the same ACB System applicant is now seeking a patent for?

(b) Are there any structural or design differences between the ACB System shown in the December 1999 advertisement of the Skin Diver magazine (Exhibit C) and the invention currently claimed? If yes, please describe and provide any substantive evidence of the differences and when such differences were made.

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(c) Was the ACB System shown in the December 1999 advertisement (Exhibit C) still developmental, experimental, and subject to change? If yes, please provide any data (e.g. records of progress, or evidence of redesign) kept by applicant/assignee noting the performance of the ACB System.

(d) Applicant's declaration on April 04, 2005 states that a prototype of the ACB System was displayed in the January 2000 DEMA show. When was the prototype manufactured? Was any prototype given, sold, exhibited or otherwise made publicly available to third parties prior to December 5, 1999?

(e) Was the ACB System advertised in the December 1999 issue of the Skin Diver magazine inoperable or subject to fundamental operation defects? If yes, explain.

(f) Was the ACB System now claimed ready for patenting prior to December 1999, specifically prior to December 5, 1999?

(g) Was the ACB System described in the December 1999 advertisement in the Skin Diver magazine (Exhibit C) ready for patenting? If no, why not?

(h) Was the Skin Diver's December 1999 issue illustrating the advertisement (Exhibit C of the Stella Affidavit) distributed to subscribers before December 5, 1999?

(i) Did the applicant advertise in any other issue of the Skin Diver Magazine prior to the December 1999 issue? If yes, what are the dates of publication of such issue(s)?

(j) Did the applicant advertise in any other publication or other form of media – electronic/digital or paper – prior to the December 05, 1999? If yes, please identify publication(s), dates and other relevant information.

(k) Did the applicant advertise or post the claimed ACB System on the Internet prior to the December 05, 1999? If yes, please identify the Internet/Web sites and other relevant information.

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(l) Did the applicant display the claimed ACB System at any other DEMA show prior to the DEMA 2000 show? If yes, what are the dates of such show(s)?

(m) Did the applicant display the claimed invention at any other industry show prior to the December 05, 1999? If yes, please identify the names and dates of such show(s)?

(n) Did the applicant/assignee offer to sell to any third party the ACB System that was advertised in the December 1999 Diver's magazine before December 5, 1999?

(o) Did any third party offer to buy from the applicant/assignee the ACB System that was advertised in the December 1999 Skin Diver's magazine before December 5, 1999?

8. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

9. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent **and to prevent possible harassment by multiple assignees**. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 2-6, 12 13 and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-32 of U.S. Patent No. 6,527,480 B2 (Angelini et al.).

Although the conflicting claims are not identical, they are not considered to be patentably distinct from each other. Claims 27-32 in Angelini et al. ('480) recite a system comprising a



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weight receiving pocket, a weight member, a weight pouch, a first strap, and a second strap associated with the weight member. The claims also recite a mechanical lock comprising a side-release connector (claim 30), wherein the side-release connector includes a male portion and a female portion (claim 31).

Although the claims do not explicitly set forth a "buckle", the Examiner takes an Official notice that buckles are notorious well known in the marine art involving diving equipment as mechanical locks/connectors of choice, wherein the buckle is designed to expose a portion of the male buckle section through a corresponding opening in the female buckle section to enable an easy disengagement of the two sections. It would have been obvious for one skilled in the art at the time of the invention to use a buckle as a preferred mechanical lock/connector in the system of Angelini et al. ('480), which would have provided an interlocking mechanism that was not only securely attachable, but also easily and quickly detachable.

Applicant may additionally note that the structure recited in the conflicting apparatus claims of Angelini et al. ('480) meets all functional limitations set forth in the claims of the instant application. Applicant is reminded that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the conflicting claims in terms of structure rather than function alone. Even when the conflicting claims fail to explicitly disclose limitations recited as functional language, if the conflicting claims (i) disclose all claimed structural limitations and (ii) the disclosed structure is capable of performing the recited function, the prior art meets the requirements of the claim.

***Allowable Subject Matter***

12. Claims 9-11 are allowed.

13. Claims 7, 8, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome the rejection of claims 2-6, 12, 13 and 16-18 based on a nonstatutory double patenting ground, provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

#### ***Response to Arguments***

15. Applicant's arguments with respect to claims 2-6, 12 13 and 16-18 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ajay Vasudeva  
Primary Examiner  
Art Unit 3617

*Ajay Vasudeva*  
7/10/07

*S. Joseph Morano*  
S. JOSEPH MORANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600